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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,238	12/22/2005	Jan C. Torfs	63207A	6110

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Intellectual Property Section
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EXAMINER	
THROWER, LARRY W	

ART UNIT	PAPER NUMBER
1791	

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10/01/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/562,238	TORFS ET AL.	
	Examiner	Art Unit	
	LARRY THROWER	1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) *14* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *04 December 2006* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/23/2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- **Group I, claim(s) 1-13**, drawn to a method for the manufacture of a molded article.
- **Group II, claim 14**, drawn to a molded article.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The common technical feature in both groups is (i) providing a mold having a surface defining a mold cavity, said surface including a negative version of a texture and a negative version of a specific texture, (ii) placing a material into said mold cavity, and (iii) molding said material to define an article, said article including a specific mark on its surface which is a positive version of the negative version of the specific texture, wherein the specific mark is visible under certain conditions and not visible under other conditions. This cannot be a special technical feature under PCT Rule 13.2, because the elements are known in the prior art.

- Wicker (U.S. Patent No. 5,722,693) teaches providing a mold having a surface defining a mold cavity, said surface including a negative version of a texture (forming background image 14; figs. 5-8) and a negative version of a specific texture (forming latent image 12; figs. 5-8; col. 3, lines 56-64; col. 5, lines 15-54), (ii) placing a material into said mold cavity (col. 5, lines 15-54; col. 3, lines 56-64), and (iii) molding said material to define an article (10), said article (10) including a specific mark (12) on its surface which is a positive version of the negative version of the specific texture (col. 3, line 56 - col. 4, line 3), wherein the specific mark (12) is visible under certain conditions and not visible under other conditions (col. 1, lines 50-54).
- Schiewe (U.S. Patent No. 5,608,718) discloses a method for the manufacture of a molded article having a specific mark on the surface thereof (abstract). The method includes providing a mold (col. 3, lines 33-52) having a surface (22) defining a mold cavity (track 10; fig. 2), said surface including a negative version of a texture (21) and a negative version of a specific texture (23), placing a material into said mold cavity (col. 1, line 65 - col. 2, line 3), and molding the material to define an article, said article including a specific mark on its surface which is a positive version of the negative version of the specific texture (23), wherein the specific mark is visible under certain conditions and not visible under other conditions (abstract).
- Therefore, a holding that these two groups do not have a single inventive concept is proper.

3. During a telephone conversation with M. Robert Christy on September 23, 2008 a provisional election was made with traverse to prosecute the invention of Group 1, claims 1-13. Affirmation of this election must be made by applicant in replying to this Office action. Claim 14 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder.

All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder**. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Drawings

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: reference character 11 in Fig. 1 is not described in the specification. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the

specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. **Claims 1-4 and 6-8** are rejected under 35 U.S.C. 102(b) as being anticipated by Wicker (US Patent No. 5,722,693).

- Regarding **claim 1**, Wicker teaches a method for the manufacture of a molded article having a specific mark on the surface thereof (abstract). The method includes providing a mold having a surface defining a mold cavity, said surface including a negative version of a texture (forming background image 14; figs. 5-8) and a negative version of a specific texture (forming latent image 12; figs. 5-8; col. 3, lines

56-64; col. 5, lines 15-54), (ii) placing a material into said mold cavity (col. 5, lines 15-54; col. 3, lines 56-64), and (iii) molding said material to define an article (10), said article (10) including a specific mark (12) on its surface which is a positive version of the negative version of the specific texture (col. 3, line 56 - col. 4, line 3), wherein the specific mark (12) is visible under certain conditions and not visible under other conditions (col. 1, lines 50-54).

- Regarding **claim 2**, Wicker discloses the specific mark (12) being visible at a predetermined viewing angle and not visible at other viewing angles (col. 1, lines 50-54).
- Regarding **claim 3**, the specific mark of Wicker is visible under a first lighting condition (abstract), and inherently would not be visible under a second lighting condition which included no visible light.
- Regarding **claim 4**, Wicker discloses the negative version of the specific version of the specific texture being laser etched into the mold surface (col. 5, lines 43-50).
- Regarding **claim 6**, Wicker discloses the negative version of the specific texture being achieved by angularly offsetting the negative version of the texture (col. 3, lines 24-32).
- Regarding **claims 7-8**, Wicker discloses the negative version of the specific texture being achieved by changing the size or depth of the negative version of the texture (col. 3, lines 7-23).

10. **Claims 1, 3-5 and 9-10** are rejected under 35 U.S.C. 102(b) as being anticipated by Schiewe (US Patent No. 5,608,718).

- Regarding **claim 1**, Schiewe discloses a method for the manufacture of a molded article having a specific mark on the surface thereof (abstract). The method includes providing a mold (col. 3, lines 33-52) having a surface (22) defining a mold cavity (track 10; fig. 2), said surface including a negative version of a texture (21) and a negative version of a specific texture (23), placing a material into said mold cavity (col. 1, line 65 - col. 2, line 3), and molding the material to define an article, said article including a specific mark on its surface which is a positive version of the negative version of the specific texture (23), wherein the specific mark is visible under certain conditions and not visible under other conditions (abstract).
- Regarding **claim 3**, Schiewe discloses the specific mark being visible under a first lighting condition and not visible under a second lighting condition (abstract).
- Regarding **claim 4**, Schiewe discloses the specific texture being laser etched into the mold surface (col. 4, lines 11-26).
- Regarding **claim 5**, Schiewe discloses the negative version of the specific texture (track 10; fig. 2) includes a plurality of indentations (21 and bordering area; fig. 2), each indentation including a protrusion (23 protrudes relative to indentation 21).
- Regarding **claim 9**, Schiewe discloses the negative version of the specific texture being contained on a mold insert (photoresist; col. 4, lines 44-53) which, when inserted into the mold, is part of the surface that defines the mold cavity (col. 4, lines 44-53).

- Regarding **claim 10**, Schiewe discloses the mold and article being injection molded (col. 1, line 65 - col. 2, line 3).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. **Claims 11-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiewe (US Patent No. 5,608,718), as applied to claim 1 above, in view of Dris *et al.* (US Patent Publication No. 2003/0044564).

- Schiewe is silent as to the material utilized to form the optical storage medium. However, Dris *et al.* discloses the use of thermoplastics such as polycarbonate and polystyrene as optical storage media (¶¶ 11-13). As taught by Dris *et al.*, these thermoplastics have the specific properties needed and meet the requirements for effective use as data storage media (¶ 11). Thus, it would have been obvious to one of ordinary skill in the art to utilize the thermoplastics taught by Dris *et al.* in the method of Schiewe to produce effective data storage devices as taught by Dris *et al.*

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LARRY THROWER whose telephone number is 571-

270-5517. The examiner can normally be reached on Monday through Friday from 9:30AM-6PM est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina A. Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Larry Thrower/
Examiner, Art Unit 1791

/Christina Johnson/

Supervisory Patent Examiner, Art Unit 1791